

REMARKS

Claims 7-9, 11-20, 26-28, and 31 are currently pending. Claims 7-9 and 11-20 have been cancelled, and claim 26 has been amended. Support for the amendment to claim 26 can be found in the specification on page 7, line 31 to page 8, line 4, and in Figures 5-8 and cancelled claims 11 and 12.

Rejection of the Claims Under 35 U.S.C. §102(b)

Reconsideration is requested of the rejection of claims 26 and 31 under 35 U.S.C. §102(b) as being anticipated by Staudinger (U.S. 5,792,091).

As amended, claim 26 is directed to a method of supporting a portion of a body. The method comprises attaching one end of an elastic band to skin on the body using an adhesive; wrapping the elastic band around the portion of the body; and securing a plurality of fingers that project from an opposing end of the elastic band to an exposed section of the elastic band. The plurality of fingers includes at least one finger that extends from the end of the elastic band along a lateral edge of the elastic band, at least one finger that extends from the end of the elastic band along an opposing lateral edge of the elastic band, and at least one finger that extends from a midsection of the end on the elastic band.

Staudinger is directed to a ready-to-use bandage for supporting and partially fixing an elbow. The bandage is a self-adhesive bandage that comprises an elongated strip having two narrow strips (i.e., an outer bridle and a proximal bridle) formed by a longitudinal incision and terminating in a recess in

the form of a triangle having a vertex located at the terminal end of the incision and a base transverse to the longitudinal direction of the bandage.

Significantly, Staudinger fails to disclose supporting a portion of a body using an elastic band having a plurality of fingers that project from an end of the elastic band, wherein the plurality of fingers includes at least one finger that extends from the end of the elastic band along a lateral edge of the elastic band, at least one finger that extends from the end of the elastic band along an opposing lateral edge of the elastic band, and at least one finger that extends from a midsection of the end on the elastic band. Rather, the bandage of Staudinger only has two narrow strips formed by a longitudinal incision and an undivided section.

As stated in MPEP §2131, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Since Staudinger fails to disclose securing a plurality of fingers that project from an opposing end of an elastic band to an exposed section of the elastic band, wherein the plurality of fingers includes at least one finger that extends from the end of the elastic band along a lateral edge of the elastic band, at least one finger that extends from the end of the elastic band along an opposing lateral edge of the elastic band, and at least one finger that extends from a midsection of the end on the elastic band, Staudinger fails to disclose each and every limitation of claim 26. As such, claim 26 is novel over the cited reference.

Claim 31 depends from claim 26 and is thus patentable for the same reasons as set forth above for claim 26 as well as for the additional elements it requires.

Rejection of the Claims Under 35 U.S.C. §102(b)/§103(a)

Reconsideration is requested of the rejection of claims 27-28 under 35 U.S.C. §102(b) as being anticipated by, or in the alternative under 35 U.S.C. §103(a) as being unpatentable over Staudinger (U.S. 5,792,091).

Claim 27 depends from claim 26 and further requires the method to comprise repositioning at least one of the plurality of fingers to customize pressure applied by the elastic band. Claim 28 depends from claim 27 and further requires that the repositioning include disengaging the at least one of the plurality of fingers from the elastic band and then securing the at least one of the plurality of fingers to another part of the elastic band.

Claims 27-28 are novel over Staudinger for the same reasons as set forth above for claim 26. Specifically, the bandage of Staudinger only has two narrow strips formed by a longitudinal incision and an undivided section. Staudinger fails to disclose supporting a portion of a body using an elastic band having a plurality of fingers that project from an opposing end of the elastic band, wherein the plurality of fingers includes at least one finger that extends from the end of the elastic band along a lateral edge of the elastic band, at least one finger that extends from the end of the elastic band along an opposing lateral edge of the elastic band, and at least one finger that extends from a midsection of the end on the elastic band. As

such, claims 27-28 are novel over Staudinger.

In the alternative, the Office has rejected claims 27-28 under 35 U.S.C. §103(a) as being obvious over Staudinger.

In order for the Office to show a *prima facie* case of obviousness, M.P.E.P. §2142 requires a clear articulation of the reasons why the claimed invention would have been obvious. Specifically, the Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398, 82 USPQ2d 1385, 1396 (2007) noted that the burden lies initially with the Office to provide an explicit analysis supporting a rejection under 35 U.S.C. 103. "[R]ejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness."¹ The Court in *KSR International* further identified a number of rationales to support a conclusion of obviousness which are consistent with the proper "functional approach" to the determination of obviousness as laid down in *Graham v. John Deere Co.* (383 U.S. 1, 148 USPQ 459 (1966)). Specifically, as previously required by the TSM (teaching, suggestion, motivation) approach to obviousness, one exemplary rationale indicated requires some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

Specifically, to reject a claim based on this rationale, the Office must articulate the following: (1) a finding that

¹ *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006).

there was some teaching, suggestion, or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings to arrive at each and every limitation of the claimed invention; (2) a finding that there was reasonable expectation of success; and (3) whatever additional findings based on the *Graham* factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness. The Office has failed to meet its burden under number (1) above, as the cited reference fails to show each and every limitation of Applicants' invention and there is no apparent reason for one skilled in the art to modify the reference to arrive at each and every limitation. It simply would not have been obvious to one skilled in the art to arrive at Applicants' claimed combinations.

Initially, applicants again submit that Staudinger fails to disclose using an elastic band having a plurality of fingers in the configuration set forth in applicants' amended claim 26 to support a portion of a body. At best, Staudinger discloses a bandage composed of an elongate strip that has an undivided section and a divided section composed of two narrow strips formed by making a dividing cut in the center of the strip, and using the bandage to support an elbow. There is no disclosure in Staudinger that the bandage described therein could or should comprise a plurality of fingers wherein the plurality of fingers includes at least one finger that extends from the end of the elastic band along a lateral edge of the elastic band, at least one finger that extends from the end of the elastic band along

an opposing lateral edge of the elastic band, and at least one finger that extends from a midsection of the end on the elastic band. This element of applicants' claims is entirely lacking from the cited reference.

Nor is there any apparent reason to modify the Staudinger reference to arrive at applicants' claimed methods. Applicants note that the bandage of Staudinger is specifically designed for supporting and partially fixing an elbow. Specifically, Staudinger states that the bandage is designed to substantially satisfy the requirements of a full tape bandage.² As discussed in Staudinger, "[t]he aim of taping is to specifically simulate the individual soft parts and capsular ligament structures and to selectively support their functions."³ To this end, the various parts of the Staudinger bandage are designed to be placed in specific locations on the arm/elbow of the user in order to provide support to the elbow. For instance, Staudinger states that the undivided section of the elongate strip "is guided from proximal to distal, over the epicondyle to the volar forearm and adhesively secured,"⁴ with the rest of this section of the bandage being "passed in an elliptical configuration around the forearm" so that it ends up lying upon itself on the outer side of the elbow and thus secures itself.⁵

Staudinger further states that "the slotted part of the bandage are first applied around the upper arm without pulling, beginning with the proximal bridle (1), and in the most

² Staudinger at col. 1, lines 27-31.

³ *Id.* at lines 12-15.

⁴ *Id.* at col. 2, lines 21-23.

⁵ *Id.* at lines 23-26.

expedient case the bridle (1) fixes itself on the upper arm."⁶ The outer bridle (i.e., one of the narrow strips of the bandage) is placed below the proximal bridle "around the distal upper arm and ends on the outer side of the elbow, most expediently on the epicondyl."⁷

Staudinger states that the proximal bridle acts as a fixation bridle and extension-limiting reinforcement, and that the outer bridle serves as a relief bridle for the epicondyle, and the wide bridle (i.e., the undivided section of the elongate strip) serves as an extension-limiting bridle on the forearm.⁸ Thus, the Staudinger bandage is configured so that each specific portion of the bandage provides support to a specific area of the elbow/arm of the user. Given the importance of the design of the Staudinger bandage, one skilled in the art would not be motivated to modify the Staudinger bandage to contain a plurality of fingers (including at least three fingers) in the configuration set forth in applicants' claims. In this regard, applicants note that "[i]f [a] proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification."⁹ In the instant case, modifying the bandage of Staudinger to have a plurality of fingers in the configuration set forth in applicants' claims would alter the specifically designed configuration of the Staudinger bandage, and possibly diminish its effectiveness in supporting the elbow. As such, there is no apparent reason for

⁶ *Id.* at lines 29-33.

⁷ *Id.* at lines 34-36.

⁸ *Id.* at lines 39-43.

⁹ See MPEP § 2143.01 (citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)).

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one skilled in the art to modify the Staudinger bandage to have the configuration of the elastic band and plurality of fingers used in the method of applicants' claims 27-28. Applicants thus submit that claims 27-28 are patentable over the cited reference.

CONCLUSION

In light of the foregoing, Applicants request withdrawal of the rejections of claims 26-28 and 31 and allowance of all pending claims. The Commissioner is hereby authorized to charge any fee which may be required to Deposit Account No. 01-2384.

Respectfully Submitted,

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